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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,731	01/19/2001	Per-Ake Minborg	57926.000006	1304

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EXAMINER

MEHRPOUR, NAGHMEH

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,731

Applicant(s)

MINBORG ET AL.

Examiner

Naghmeh Mehrpour

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 01 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/1/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed reference listed in the information Disclosure submitted on 09/11/04 have been considered by the examiner (see attached PTO-1449

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7, 9, 11-12, 14, 16, are rejected under 35 U.S.C. 103(a) as being unpatentable over Norby et al.(US Patent 5,933,486).

Regarding claims 1, 14, Norby teaches a method for communicating between first and second communication devices, comprising:

receiving, at a first server 14, with the first communication device (originating call), a first signal from the first communication device (originating device);

Art Unit: 2686

the first signal comprising a first request for a data object associated with a second communication device (terminating device) and including at least an identity of the second device 20 (col 2 lines 50-60);

providing the first mobile communication device the data object associated with the second communication device (20 or terminating device) (col 2 lines 50-60);

as a result of the first request by the first communication device, providing identification information of the first communication device that enables the second communication device to access a data object associated with the first communication device (originating device) (col 3 lines 27-33); and

providing to the second communication device 20 a data object (dialing number)associated with the first communication device (originating call) based on the provided identification information of the first communication device (col 3 lines 34-62). Norby fails to teach that the communication devices are mobile communication devices. However Examiner takes official notice that the mobile communication device is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching with Norby's system, in order to enable the user to move to different location when he desires, in the communication system.

Regarding claim 2, Norby teaches a method wherein the first signal includes a dialed number of the called party 20 (second device) and the identification of the first device (originating call) (see figure 1, col 2 lines 50-60).

Art Unit: 2686

Regarding claims 3, 9, Norby teaches a method wherein the data object provided to the second communication device (terminating call or site 20) that is associated with the first communication device (originating call) is rendered without using calling line interface information (CLI) (col 3 lines 29-43).

Regarding claim 4, Norby teaches a method for communicating between first originating calls and second terminating calls (see figure 1) communication devices, comprising:

- identifying, at the second device (terminating calls or sites 20), the occurrence of a triggering event (col 4 lines 4-12);

- Second device (terminating calls or sites 20) transmitting a request to a second server 16 a data object (see figure 1, col 3 lines 65-67, col 4 lines 1-3);

- receiving the requested data object from the second server 16 (col 4 lines 2-12);

- the request for a data object by the second communication device (destination or terminating calls) for a data object associated with the first communication device (originating calls) is fulfilled only if the first communication device a requested a data object associated with the second communication device (col 3 lines 29-45).

Regarding claim 5, Norby teaches a method wherein the triggering event does not includes a calling line identification (CLI) information of the first communication device (col 3 lines 29-58).

Art Unit: 2686

Regarding claim 7, Norby teaches a method for communicating wherein the requested data object associated with the first communication devices that is provided to the second communication device is generated in the server based on calling information provided by a second server 16 associated with the first communication device new opportunities for users and for service providers (col 3 lines 29-63).

Regarding claim 12, Norby teaches a method wherein the data object associated with the first communication device that is provided to the second communication device includes a phone page of the first communication device (col 6 lines 5-15).

Regarding claim 16, Norby teaches a method wherein the second communication device 252 is unable to access the data object associated with the first communication 232 device unless the first communication device requests the data object with the second communication device (col 6 lines 5-15).

4. Claim 11, is rejected under 35 U.S.C. 103(a) as being unpatentable over Norby (US Patent 5,946,684) in view of Zaras et al. (US Patent Number 6,625,644 B1).

Regarding claim 11, Norby fails teaches a method wherein the data object associated with the first communication device that is provided to the second communication device includes a pointer to the phone page of the second device. However Zaras teaches a method wherein the data object associated with the first communication device that is provided to the second

Art Unit: 2686

communication device includes a pointer to the web page of the second device (see figure 2, col 4 lines 13-15). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Zaras with Norby, in order to provide a method for internally searching in a website for a particular web page.

5. Claims 13, 15, are rejected under 35 U.S.C. 103(a) as being unpatentable over Norby (US Patent 5,946,684) in view of Porter (US Patent Number 2002/0059272 A1).

Regarding claims 13, 15, Norby fails to teach a method wherein the data object associated with the first communication device that is provided to the second communication device comprises the public identity of the second device. However Porter teaches a method wherein the data object associated with the first communication device that is provided to the second communication device comprises the public identity of the second device (see figure 2, col 3 lines 56-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Porter with Norby, in order to allow users to address an individual message as response to a previous message.

6. Claim 17, is rejected under 35 U.S.C. 103(a) as being unpatentable over Norby (US Patent 5,946,684) in view of Tejada (US patent Number 2002/0068550 B1).

Regarding claim 17, Norby fails to teach a method wherein the first communication device has a secret or unlisted phone number such that the phone number is not automatically made available

Art Unit: 2686

to called parties as CLI information. However Tejada teaches a method wherein the first communication device has a secret or unlisted phone number such that the phone number is not automatically made available to called parties as CLI information (page 2 section 0029).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Tejada with Norby, in order to provide to a third party, a requested wireless phone number of a person if the set of conditions associated with that wireless phone number have been met.

Allowable Subject Matter

7. Claim 10, is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments with respect to claims 1-7, 9, 11-17, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. **Any responses to this action should be mailed to:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naghmeh Mehrpour whose telephone number is 703-308-7159.

The examiner can normally be reached on 8:00- 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold be reached (703) 305-4379.

Art Unit: 2686

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NM

November 17, 2004

MELODY MEHRPOUR
PATENT EXAMINER
